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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,006	03/15/2001	Colin l'Anson	1509-148	4592

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,006

Applicant(s)

I'ANSON, COLIN

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is in response to applicant's response filed on July 7, 2005. **Claims 1-9, 14 and 17** are now pending in the present application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-9, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brilla et al. US Patent 6,389,276 in view of Helferich US Patent 6,636,733 and further in view of Shaffer US Patent 6,021,114.

Regarding claim 1, Brilla teaches a method of transferring recorded audio messages to a mobile entity across a mobile radio infrastructure, (abstract), the method comprising:

transferring to a service system a voice call made by a caller towards the mobile entity but which cannot be completed, (col. 4, lines 28-35);

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recording at the service system an audio message from the caller and forming the call into a data message (e.g. e-mail message) addressed to the mobile entity, (col. 4, lines 33-39); and

pushing a data message to the mobile entity over a data-capable bearer service of the mobile radio infrastructure, (col. 4, lines 39-45 and col. 6, lines 3-15); and

storing the data message in the mobile entity for subsequent access by a user, (col. 4, lines 39-45 and col. 6, lines 3-15).

While Brilla teaches of recording an audio message from the caller and pushing a data message to a mobile entity for notification of the message, Brilla does not specifically teach of pushing the recorded audio message to the mobile entity.

In the same field of endeavor, Helferich teaches of recording audio messages from callers and forming the recorded audio message into a data message addressed to a mobile entity, (col. 6, lines 50-63). Helferich further teaches of pushing the data message to the mobile entity over a data-capable bearer service for a mobile radio infrastructure, (col. 7, lines 56-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brilla by pushing the recorded audio message to the mobile entity as taught by Helferich so that the mobile entity can quickly received messages that have been addressed to them.

Brilla in view of Helferich do not specifically teach of pushing the data message to the mobile entity at a time determined with a view to avoid peak traffic.

In the same field of endeavor, Shaffer teaches of sending messages over a data-capable bearer service of a wireless radio infrastructure (col. 4, lines 35-48; the communication medium that the message is sent over can be a wireless infrastructure) and at a time determined with a

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view to avoiding peak traffic loading of the radio infrastructure, pushing the data message to the mobile entity over a data-capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; col. 7, lines 9-22; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 2, Brilla in view of Helferich, as applied above to claim 1, teaches everything except pushing the message at a time corresponding to an off-peak time, however, as shown above, Shaffer teaches wherein the data message is pushed to the mobile entity at a time corresponding to an off-peak charging rate through the mobile radio infrastructure (col. 4, lines 35-48) according to a predetermined tariff schedule held or accessed by the service system, (computer network server), (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 3, Brilla, as applied above to claim 1, teaches everything except pushing the message at a time corresponding to an off-peak time, however, as shown above, Shaffer teaches wherein the data message is pushed to the mobile entity (col. 4, lines 35-48) at a

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time corresponding to an off-peak charging rate through the mobile radio infrastructure according to a charging schedule dynamically changed to take account of the actual loading of the mobile radio infrastructure, this schedule being accessed at least periodically by the service system, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 4, Brilla, as applied to claim 1, teaches wherein the data message is pushed to the mobile entity as shown above. Brilla does not teach at a time preset according to a schedule agreed upon with the operator of the mobile radio infrastructure for avoiding peak load periods on the infrastructure.

In the same field of endeavor, Shaffer teaches wherein the data message is pushed to the mobile entity at a time preset according to a schedule agreed upon with the operator of the mobile radio infrastructure for avoiding peak load periods on the infrastructure, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 5, Brilla, as applied to claim 1, wherein the data message is pushed to the mobile entity. Brilla in view of Helferich do not specifically teach at a time negotiated with an arbitration system in communication with the mobile radio infrastructure, to satisfy transfer parameters specified by the service system for transfer of the data message through the mobile radio infrastructure.

In the same field of endeavor, Shaffer teaches wherein the data message is pushed to the mobile entity at a time negotiated with an arbitration system in communication with the mobile radio infrastructure, to satisfy transfer parameters specified by the service system for transfer of the data message through the mobile radio infrastructure, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 6, Brilla, as applied to claim 1, teaches wherein the data message is pushed to the mobile entity in response to the mobile radio infrastructure indicating to the service system that the mobile entity is available to receive the data message, (col. 4, lines 39-45 and col. 6, lines 3-15).

Regarding claim 7, Brilla, as applied to claim 1, teaches converting the voice call to text at the service system for incorporation into the data message, (col. 4, lines 39-45 and col. 6, lines 3-15).

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Regarding claim 8, Brilla, as applied to claim 1, teaches supplying the service system with a called party ID identifying the mobile entity in response to transfer of the voice call to the service system and using the called party ID to and using the called party ID to look up a destination address for the data message in response to the called party ID, (col. 4, lines 39-45 and col. 6, lines 3-15).

Regarding claim 9, Brilla, as applied to claim 1, teaches wherein the data message is an e-mail message, (col. 4, lines 39-45 and col. 6, lines 3-15).

Regarding claim 14, Brilla, teaches a method of transferring recorded audio messages to a mobile entity across a mobile radio infrastructure, (abstract), the method comprising the steps of:

(a) transferring to a service system an uncompleted voice call made by a caller towards the mobile entity, (col. 4, lines 28-35),

(b) recording an audio message from the caller and forming the uncompleted call into a data message addressed to the mobile entity, (col. 4, lines 33-39); and

(c) subsequently pushing, the data message (an e-mail message is pushed) to the mobile entity over a data-capable bearer service for the mobile radio infrastructure, (col. 4, lines 39-45; col. 6, lines 3-15).

While Brilla teaches of recording an audio message from the caller and pushing a data message to a mobile entity for notification of the message, Brilla does not specifically teach of pushing the recorded audio message to the mobile entity.

In the same field of endeavor, Helferich teaches of recording audio messages from callers and forming the recorded audio message into a data message addressed to a mobile entity, (col.6

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lines 50-63). Helferich further teaches of pushing the data message to the mobile entity over a data-capable bearer service for a mobile radio infrastructure, (col. 7, lines 56-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brilla by pushing the recorded audio message to the mobile entity as taught by Helferich so that the mobile entity can quickly received messages that have been addressed to them.

Brilla in view of Helferich do not specifically teach pushing at a non-peak traffic loading time of the mobile radio infrastructure the data message to the mobile entity.

In the same field of endeavor, Shaffer teaches of sending messages over a data-capable bearer service of a wireless radio infrastructure (col. 4, lines 35-48; the communication medium that the message is sent over can be a wireless infrastructure) and at a time determined with a view to avoiding peak traffic loading of the radio infrastructure, pushing the data message to the mobile entity over a data-capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; col. 7, lines 9-22; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla and Helferich by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 17, Brilla teaches an apparatus for enabling recorded audio messages to be transferred to a mobile entity across a mobile radio infrastructure (abstract), said apparatus comprising:

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a receiver for an uncompleted voice call made towards the mobile entity, (col. 4, lines 28-35);

a message handler for recording an audio message from the caller and forming the uncompleted call into a data message addressed to the mobile entity, (col. 4, lines 33-39);

a memory for storing the data message, (col. 4, lines 33-39); and

a transmitter for retrieving the stored data message and pushing the retrieved stored data message toward the mobile entity via a data-enabled bearer service of the mobile radio infrastructure, (col. 4, lines 39-45; col. 6, lines 3-15).

While Brilla teaches of recording an audio message from the caller and pushing a data message to a mobile entity for notification of the message, Brilla does not specifically teach of pushing the recorded audio message to the mobile entity.

In the same field of endeavor, Helferich teaches of recording audio messages from callers and forming the recorded audio message into a data message addressed to a mobile entity, (col. 6, lines 50-63). Helferich further teaches of pushing the data message to the mobile entity over a data-capable bearer service for a mobile radio infrastructure, (col. 7, lines 56-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brilla by pushing the recorded audio message to the mobile entity as taught by Helferich so that the mobile entity can quickly received messages that have been addressed to them.

Brilla in view of Helferich do not specifically teach at a non-peak traffic loading time of the mobile radio infrastructure pushing the data message to the mobile entity.

Shaffer teaches of a transmitter for sending messages over a data-capable bearer service of a wireless radio infrastructure and at a time determined with a view to avoiding peak traffic loading of the radio infrastructure, pushing the data message to the mobile entity over a data-capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Response to Arguments

5. Applicant's arguments filed July 7, 2005 have been fully considered but they are not persuasive.

Applicant contends that Helferich is not concerned with converting a recorded audio message to a data message that is pushed to a mobile phone. The Examiner respectfully disagrees.

The Examiner did not rely upon Helferich for conversion of a voice message into a data message but for pushing a recorded audio message to a mobile entity. Brilla, the primary reference, was relied upon for forming a data message based on the audio message and for pushing the data message. Helferich was used for the well known teaching of pushing the recorded message to the recipient. Column 6, lines 50-63 discloses including a recorded voice message into an e-mail message and col. 7, lines 56-67 teaches of pushing the e-mail message to

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the message recipient. Brilla teaches of recording an audio message from the caller and forming information on the recorded audio message into a data message but does not specifically teach that the recorded audio message itself is pushed to the mobile entity. Thus the combination of Brilla and Helferich will provide a system wherein an audio message is recorded and formed into a data message and wherein the data message is pushed to the mobile entity.

Applicant further argues that the voice attachment is Helferich is not converted into a data message and pushed to the mobile phone and instead is used by the message processor to play a voice message to the mobile phone as a phone call. The Examiner respectfully disagrees.

As explained above, the Examiner did not rely on Helferich for the teaching of converting a voice message into a data message but for pushing the data message with a voice attachment which was recorded from a caller to the message recipient.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "converting" a recording audio message to a data message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant explains that incorporating Shaffer's delay feature would actually add to the cost and hence would contravene the objects of the Brilla system. Applicant further argues that Brilla and Shaffer arrangements are completely different from one another. Therefore, there is not motivation to combine Shaffer with Brilla and Helferich. The Examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Helferich teaches of pushing the message to recipient so that the mobile entity can quickly receive the message and the use of avoiding peak traffic as taught by Brilla would have been obvious to one of ordinary skill in the art so that the overall costs can be reduced.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any response to this action should be mailed to:

Commissioner for Patents

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P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label

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Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

A handwritten signature in cursive script that reads "Ovidio Escalante".

Ovidio Escalante
Examiner
Group 2645
September 9, 2005

O.E./oe